

Remarks/Arguments:

A substitute specification and Rule 125 statement—as required in the Office Action—are concurrently submitted, herewith.

Claims 1 and 2 are pending.

Claim 1 is presently amended in order to clearly define the instant invention. Specifically, the presently claimed "sealant" is identified as an "adhesive sealant," i.e., to expressly recite the physical property of the "sealant" inherent in its recited "bonding" functionality. In other words, in order for the "sealant" — as defined in the original claims— to function for its intended purpose (i.e., "bonding"), the "sealant" must have adhesive properties; which adhesive properties are, in fact, disclosed in the instant specification (e.g., Abstract). As such, the claims, as currently amended, define the same subject matter as in the original claims.

The objection to the disclosure is overcome in view of filing the substitute specification and Rule 125 statement (mentioned above). Withdrawal of the objection appears to be in order.

Claims 1 and 2 were rejected under 35 USC 102(b) as being allegedly anticipated by U.S. Patent No 5,314,941 to Yamanaka et al. ("Yamanaka"). Claims 1 and 2 were rejected under 35 USC 102(b) as being allegedly anticipated by U.S. Patent No 5,344,864 to Kushida et al. ("Kushida"). Claims 1 and 2 were rejected under 35 USC 102(b) as being allegedly anticipated by U.S. Patent No 5,484,844 to Oshima et al. ("Oshima"). Reconsideration of the rejections is requested.

The statements of rejection implicitly allege that each of Yamanaka, Kushida, and Oshima fully meets each of the rejected claims. With all due respect, the statements of rejection are both legally and factually mistaken.

For anticipation under §102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The "absence" from a prior art reference of a single claim limitation "negates anticipation." *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

The properties exhibited by a claimed invention must be taken into consideration when comparing the claims against the prior art, whether or not the properties are recited in the claims. *In re Estes*, 164 USPQ 519 (CCPA). See *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963) ("From the standpoint of patent law, a compound and all of its properties are inseparable").

A claim limitation (e.g., a substance) is not met by a reference that uses the limitation for a function other than the function for which it is used in the claims, since claims do not read on the prior art if "chemicals, although present in the prior art, were used for other non- . . . [claimed] functions and did not [perform the claimed function] . . . as . . . understood from the . . .

specification." *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 24 USPQ2d 1321, 1327 (Fed. Cir. 1992).

A limitation on the presently claimed "sealant" is its function of "bonding of an inner screen to the inner panel of an automobile door"; which panel bonding, as well known in the automotive art, involves "using a special adhesive to glue body panels in place" (*Dictionary of Automotive Terms*, online, URL: <http://www.motorera.com/dictionary/PA.HTM> and <http://www.motorera.com/dictionary/BO.HTM>, relevant pages attached). None of the allegedly anticipating reference (relied on in the rejections) teaches or suggests a sealant that can function in the manner to which the rejected claims are limited. Claims do not read on the prior art if "chemicals, although present in the prior art, were used for other non- . . . [claimed] functions and did not [perform the claimed function] . . . as . . . understood from the . . . specification." *Minnesota Mining & Manufacturing Co.*, 24 USPQ2d at 1327.

Yamanaka discloses a thermoplastic elastomer resin composition, described as having good high-temperature creep characteristics and excellent compression set. According to the reference a crystalline chlorinated polyethylene, a rubber material of NBR or SBR, a plasticizer, and a filler are incorporated in the thermoplastic elastomer resin composition.

Salient differences between **Yamanaka** and the present claims can be readily pointed out:

– According to Yamanaka a crystalline chlorinated polyethylene is necessarily used, since without this component the elastomer resin becomes rigid and, thus, lead to deteriorated processability and formability.

– The composition disclosed in Yamanaka is used for molded articles such as glass (window) runners and weather strips. Making and using such molded articles provides neither teaching nor suggestion to make and use an adhesive sealant, as presently claimed.

– There is no description or suggestion in Yamanaka to the use the thermoplastic elastomer resin composition as a sealant (i.e., adhesive) for bonding articles to automobile doors, such as provided in accordance with the presently claimed invention.

Kushida discloses a thermoplastic elastomer resin composition, described as having good high-temperature creep characteristics and excellent compression set. According to the reference a vinyl chloride resin, NBR, a plasticizer, and a filler are incorporated in the thermoplastic elastomer resin composition.

Salient differences between **Kushida** and the present claims can be readily pointed out:

– According to the disclosure in Kushida, a vinyl chloride resin is necessarily used, since without this component the elastomer resin exhibits poor tensile strength, elongation, and tearing strength.

– The composition disclosed in Kushida is invented for the purpose of improving creep characteristics and compression set, in molded articles such as packings, glass runners, gaskets, and sheets. Making and using such molded articles provides neither teaching nor suggestion to make and use an adhesive sealant—useful in bonding materials to automobile doors—such as provided in accordance with the presently claimed invention.

Oshima discloses a thermoplastic elastomer resin composition, described as having creep resistance and excellent compression set. According to the reference a vinyl chloride resin, NBR, a plasticizer, and filler are incorporated in the thermoplastic elastomer resin composition.

Salient differences between **Oshima** and the present claims can be readily pointed out:

- According to the disclosure in Oshima, a vinyl chloride resin is necessarily used, since without this component the composition exhibits poor moldability, which impairs extrusion-molding.

- As taught by Oshima (column 10, lines 25-29):

The vinyl chloride resin elastomer composition of the present invention has the low temperature flexibility improved without impairing other properties such as compression set, moldability, heating test of molded product and blocking resistance by substituting a chlorinated polyethylene for a part of the vinyl chloride resin in the elastomer comprising the vinyl chloride resin, the NBR containing a partially cross-linked gel content and the plasticizer. It can be used as a material for not only extrusion molding but also calendar processing, injection molding, inflation molding or compression molding, whereby a molded product having an optional or predetermined shape can be obtained.

The vinyl chloride resin elastomer composition of the present invention is useful in a wide range of industrial, automobile and building applications, for example, for weather strips, glass runs, packings, gaskets, hoses, sheets, grips, rolls, grommets, duct boots and cushion materials.

Making and using a "molded product," such as "glass runs" and "weather strips," obtained by (e.g.) "extrusion molding" a "vinyl chloride resin elastomer composition"—as described by Oshima—provides neither teaching nor suggestion to make and use an adhesive sealant—useful in bonding materials to automobile doors—such as provided in accordance with the presently claimed invention.

In each of the cited references a vinyl chloride resin or a chlorinated polyethylene resin is used as a component of the elastomer product. On the other hand, the presently claimed invention comprises partially crosslinked (i) butadiene-acrylonitrile rubber (NBR), (ii) butadiene-styrene rubber (SBR), or both.

Each of Yamanaka, Kushida, and Oshima discloses a thermoplastic elastomer composition for molded products such as glass runners channels, gaskets and packings. Neither reference teaches or suggests any conception or use of a sealant having adhesive properties (i.e., bonding functionality) such as according to the presently claimed invention.

The PTO relies on the word *sealing* (or something similar) being associated with disclosed products—in each of Yamanaka, Kushida, and Oshima—in alleging that those products fully meet (i.e., anticipate) the presently claimed "sealant." For example Yamanaka (column 5, lines 39-40) (emphasis added) teaches its thermoplastic elastomer composition being useful as "a window sealing material for automobiles." However, mere orthographic similarity between "sealant" and "sealing" does not equate one with the other in the context of comparing the present claims with each of the cited references.

In each of the cited references it is a molded product—of a thermoplastic elastomer—which has the *sealing* effect. Such a molded product is inherently not an "adhesive," as opposed to the presently claimed invention. For example, to be useful as a glass runner (as used in the cited references) the molded product cannot be an adhesive, i.e., it would stick to the glass and, so, the glass could not "run." On the contrary, the presently claimed "sealant for automobile doors" effects

"bonding" and, so, functions as an adhesive—as now expressly recited in the claims as currently amended.

Accordingly, the "absence" from Yamanaka of the adhesive limitation "negates anticipation" of the rejected claims by the reference. *Kolster Speedsteel A B*, 230 USPQ at 84. To anticipate the claim, each claim limitation must "identically appear" in the reference disclosure. *Gechter*, 43 USPQ2d at 1032. The adhesive (i.e., bonding) properties exhibited by the presently claimed invention, whether or not recited in the claims, must be taken into consideration when comparing the claims against the prior art. *Estes, supra*.

Further, accordingly, the "absence" from Kushida of the adhesive limitation "negates anticipation" of the rejected claims by the reference. *Kolster Speedsteel A B*, 230 USPQ at 84. To anticipate the claim, each claim limitation must "identically appear" in the reference disclosure. *Gechter*, 43 USPQ2d at 1032. The adhesive (i.e., bonding) properties exhibited by the presently claimed invention, whether or not recited in the claims, must be taken into consideration when comparing the claims against the prior art. *Estes, supra*.

Further still, accordingly, the "absence" from Oshima of the adhesive limitation "negates anticipation" of the rejected claims by the reference. *Kolster Speedsteel A B*, 230 USPQ at 84. To anticipate the claim, each claim limitation must "identically appear" in the reference disclosure. *Gechter*, 43 USPQ2d at 1032. The adhesive (i.e., bonding) properties exhibited by the presently claimed invention, whether or not recited in the claims, must be taken into consideration when comparing the claims against the prior art. *Estes, supra*.

For the foregoing reasons, the rejection of claims 1 and 2 under §102(b) based on Yamanaka is overcome. Withdrawal of the rejection appears to be in order.

For the foregoing reasons, the rejection of claims 1 and 2 under §102(b) based on Kushida is overcome. Withdrawal of the rejection appears to be in order.

For the foregoing reasons, the rejection of claims 1 and 2 under §102(b) based on Oshima is overcome. Withdrawal of the rejection appears to be in order.

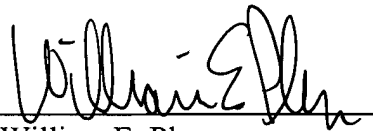
Request for Examiner's Initialed Form PTO 1449

On May 15, 2006, an Information Disclosure Statement (IDS), including completed Form PTO 1449 and copies of the cited references, was filed in the PTO. Attached hereto is a copy of the post card receipt for the IDS, date stamped by the PTO. The submitted Form PTO 1449, initialed by the Examiner to show consideration of the references cited thereon, was neither attached to the instant Office Action nor included with any other paper issued by the PTO.

Accordingly, it is requested that the PTO return the submitted Form PTO 1449, initialed by the Examiner to show that the references cited, thereon, were considered by the Examiner during prosecution of the subject application.

Favorable action is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

William E. Player
Reg. No. 31,409
Attorney of Record

JACOBSON HOLMAN PLLC
400 Seventh Street, NW
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: January 9, 2009
WEP/aer

R:\WPLAYE\wep&secretary\2009\January\P71250US0 amd.wpd

Scuttle panel
Scuttle side panel
Seat well
Shelf panel
Side bumper panels
Side panel
Solar Thermal Panels
Splash panel
Squab panel
Straightened panel
Sunroof aperture panel
Trim panel
Under sill panel
Wheel house panel
Wheel panel
Windshield corner panel
Windshield header panel
Windshield panel

Panel beater

1. A person who beats out the dented bodywork of a damaged vehicle.
2. A **Panel hammer**

Panel beating

Beating out the dents in damaged bodywork.

Also See

Off-the-dolly panel beating
On-the-dolly panel beating

Panel bonding

A new repair process using a special adhesive to glue body panels in place instead of spot-welding them

Panel contour

The normal shape of a new, undented body panel as produced by the factory

Panel cutter

An air-operated tool used to cut out old panels. It is a relatively coarse tool and is thus suited mainly for cutting sheet metal in areas where minor distortion along the cutting lines does not matter.

Also see

Manual panel cutter

Panel file

See

current or in an oven or both for the plastic to set and the coil to attain a solid permanent form.

Bonding

1. The electrical interconnection of metallic parts of an aircraft normally at ground potential for the safe distribution of electrical charges and currents. Protects against charges due to precipitation, static and electrostatic induction due to lightning strikes. Reduces interference and provides a low-resistance electrical return path for current in ground-return systems.
2. Joining structural parts by adhesive. May be performed at high temperature and pressure.

Also See

Adhesive bonding

Panel bonding

3. An electrical connection between adjacent lengths of armoring or across a joint.
4. The interactions between individual atoms and molecules.

Also See

Chemical bond

Bonding agent

1. A material which provides adhesion.
2. The cement used to secure **Bonded linings** to a brake shoe.

Bonding clip

A clip used in wiring systems to make connection between the grounded metal sheath of different parts of the wiring, in order to ensure continuity of the sheath

Bonding method

A procedure of joining two components with adhesive.

Bonding range

The time during which a satisfactory bond can be made. It is usually expressed in two numbers, the first number being the time in minutes one must wait after applying adhesive before trying to bond the surfaces, and the latter number being the longest drying period within which satisfactory bonds can be made, usually ten to 30 minutes after applying the adhesive.

Bond length

The minimum length of reinforcing bar required to be embedded in concrete to ensure that the bond develops the full stress in the bar.

Bondo®

A **body putty** manufactured by 3M

Bond strength